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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197504
Party	Plaintiff Omega SA (Omega AG) (Omega Ltd.)
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Date	08/31/2015
Attachments	K655 Opposer's Opp to Applicant's Notice of Supplemental Legal Authority.pdf(172975 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OMEGA S.A. (OMEGA AG) (OMEGA LTD), Opposer, v. ALPHA PHI OMEGA, Applicant.	Mark: ALPHA PHI OMEGA and design Opp. No.: 91197504 (Parent) Serial No.: 77950436
OMEGA S.A. (OMEGA AG) (OMEGA LTD), Opposer, v. ALPHA PHI OMEGA, Applicant.	Mark: ΑΦΩ Opp. No.: 91197505 (Child) Serial No.: 77905236

OPPOSER'S OPPOSITION TO APPLICANT'S NOTICE OF SUPPLEMENTAL LEGAL AUTHORITY

I. Applicant's Submission Should be Stricken as an Impermissible Surreply

Surreply briefs are impermissible in proceedings before the Board, pursuant to TBMP § 502.02(b). *See also* 37 CFR § 2.127(a), (e)(1); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies,* 73 USPQ2d 1672, 1677 (TTAB 2005) (because 37 CFR§ 2.127(a) prohibits the filing of surreply briefs, opposer's surreply to applicant's motion was not considered); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000). To the extent that Applicant presents new arguments in its submission regarding the applicability of the Federal Circuit's decision, as opposed to simply bringing the decision to the Board's attention, it constitutes a surreply in

support of its Motion for Summary Judgment (DE 58) or an unconsented motion. As a result, Applicant's August 11, 2015 submission should be stricken and given no consideration.

II. Applicant's Submission Should be Stricken as it violates the Board's March 4, 2015 Order (DE 72) as an Impermissibly Filed Unconsented Motion

On March 4, 2015 the Board issued an Order prohibiting the parties from filing any unconsented motion without prior permission. DE 72 at 17-18. Applicant's submission is an unconsented motion and it should be stricken and given no consideration.

III. Applicant Mischaracterizes the Federal Circuit's Decision in *Juice Generation, Inc. v. GS Enters. LLC*

Applicant cites to *Juice Generation, Inc. v. GS Enters, LLC*, 015 U.S. App. LEXIS 12456 (Fed. Cir. 2015), for the proposition that in a likelihood of confusion analysis, it is an error to focus on the portion of the challenged mark that subsumes the asserted mark, particularly if it is used by various third-party marks in the industry. *See* DE 83 at 1-2. This is not what the Federal Circuit held. In fact, it held that the Board's analysis comparing the challenged mark, PEACE LOVE JUICE, and the asserted mark, PEACE & LOVE, was insufficient because it did not "set forth an analysis showing that it avoided the error of giving no significance to the term ["juice"], notwithstanding that the term is generic and disclaimed." *Juice Generation, Inc.*, 2015 U.S. App. LEXIS at *14 (Fed. Cir. 2015). The Federal Circuit's decision simply recognizes the well-established principle that "there is nothing improper in stating that for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *Id.* (*quoting In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985).

In contrast to Applicant's claims that the decision stands for the proposition that it is an "error to focus on the portion of the challenged mark that subsumes the asserted mark," DE 83 at 1-2, the Court's decision is an explicit recognition that certain components of a mark may be given heightened consideration for appropriate reasons, so long as all components and the marks in their entirety are accounted for in the analysis. In this proceeding, it is appropriate to give the "OMEGA" portion of Applicant's mark heightened importance due to fame and widespread recognition of Opposer's OMEGA marks, presuming the Board recognizes and explains the importance, or lack thereof, given to the remainder of Applicant's mark.

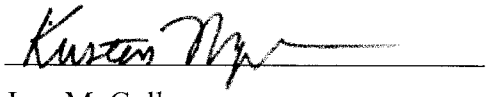
Applicant also claims that the *Juice Generation* decision stands for the proposition that proffered evidence of third-party use, if uncontradicted, is "adequate proof." DE 83 at 2. Applicant does not specify exactly what such evidence proves. The Court's decision does not hold that evidence of third-party use of a mark, without specific information regarding the extent of such use, can establish that customers have become conditioned to recognize that multiple entities use the mark for similar goods or services. 2015 U.S. App. LEXIS 12456, *8-9.

The Court's decision holds that such evidence may be used similar to dictionary definitions, to shed light on whether a mark is suggestive of descriptive in a particular industry. *Id.* at *11-12. This was a particularly important inquiry in the *Juice Generation* case because of statements the senior use made to the Trademark Office that would support the argument that its mark is suggestive or descriptive. *Id.* There is no such issue or evidence in this proceeding.

Critically, as a corollary, the Court recognized that the consideration of third-party use for the placement of a mark on the fanciful-suggestive-descriptive-generic continuum is a question of fact. *Id.* at *12 (quoting *In re Net Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001). As such, it is not an inquiry appropriately addressed at summary judgment. This

outstanding question of fact further supports the denial of Applicant's Motion for Summary Judgment.

Respectfully Submitted,

By: 

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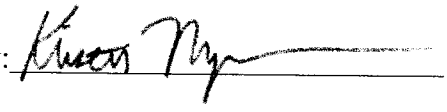
Date: August 31, 2015
JMC/TPG/KAM

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED THROUGH THE ELECTRONIC SYSTEM FOR TRADEMARK TRIAL AND APPEALS IN THE UNITED STATES PATENT AND TRADEMARK OFFICE.

COLLEN *IP*

By:  Date: August 31, 2015

CERTIFICATE OF SERVICE

I, Meagan Machanski, hereby certify that a copy of the foregoing **Opposer's Opposition to Applicant's Notice Of Supplemental Legal Authority** was served by First Class U.S. Mail, postage prepaid on this 31st Day of August, 2015 upon

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